

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: June 20, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Petrossian Inc.*  
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Serial No. 79177698  
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Timothy H. Hiebert of Samuels & Hiebert LLC,  
for Petrossian Inc.

Ronald L. Fairbanks, Trademark Examining Attorney, Law Office 119,  
Brett J. Golden, Managing Attorney.

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Before Zervas, Kuczma, and Lynch,  
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

Petrossian Inc. (“Applicant”) seeks to register on the Principal Register, pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), the mark

**PETROSSIAN** for “Soaps; perfumery, essential oils, cosmetics; All the

aforesaid goods being sold in delicatessen shops” in International Class 3.<sup>1</sup> The

Examining Attorney refused registration on the ground that the proposed mark is

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<sup>1</sup> Application Serial No. 79177698, with an effective filing date of October 8, 2015, is based on Section 66(a) of the Trademark Act, 15 U.S.C. §1141f(a). The mark is PETROSSIAN in a stylized font.

primarily merely a surname under Section 2(e)(4), 15 U.S.C. § 1052(e)(4) and that Applicant's proffer of acquired distinctiveness under Section 2(f) is insufficient. When the Examining Attorney made the refusal final, Applicant requested reconsideration and appealed. After the Examining Attorney denied the request for reconsideration, the appeal resumed.

On appeal, Applicant does not contest the underlying refusal under Section 2(e)(4), but instead presents the sole issue as the sufficiency of its Section 2(f) claim, which was not made in the alternative.<sup>2</sup> Specifically, Applicant's brief characterizes the question on appeal as whether the Examining Attorney erred in rejecting the Section 2(f) claim that was based only on prior registrations of the same mark because their identified goods were not sufficiently similar or related to the goods in the subject application.<sup>3</sup>

We determine whether Applicant's mark has acquired distinctiveness based on the entire record, keeping in mind that "[t]he applicant ... bears the burden of proving acquired distinctiveness." *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (citation omitted). Acquired distinctiveness may be proven by, *inter alia*, "ownership of one or more active prior registrations on the Principal Register or under the Trademark Act of 1905 of the same mark ... if the goods or

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<sup>2</sup> *Cf. The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) ("Where an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive."). We also find, based on the evidence and arguments in the Examining Attorney's brief, that the record contains substantial evidence to support the refusal under Section 2(e)(4).

<sup>3</sup> 7 TTABVUE 2 (Applicant's Brief).

services are sufficiently similar to the goods or services in the application.” 37 C.F.R. § 2.41(a). Thus, an applicant can establish acquired distinctiveness by showing that the same mark previously acquired distinctiveness for sufficiently similar or related goods, and that this acquired distinctiveness therefore will transfer to the goods in the new application when the mark is used in connection with them. *See, e.g., In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001); *In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1273-74 (TTAB 2016); *In re Nielsen Bus. Media Inc.*, 93 USPQ2d 1545, 1547 (TTAB 2010). To establish that such a transfer will take place, Applicant must show a sufficient similarity or relationship between the goods in the prior registrations and those identified in the new application, so that the purchasing public will perceive that the mark’s primary significance when used on the new goods is to identify Applicant as the source. *In re Olin Corp.*, 124 USPQ2d 1327, 1333-34 (TTAB 2017) (citing *In re Binion*, 93 USPQ2d 1531, 1538 (TTAB 2009) and *In re Rogers*, 53 USPQ2d 1741, 1744-45 (TTAB 1999)).

Applicant relies on its three prior registrations for the same mark or a legally identical mark (PETROSSIAN in typed form):

- Registration No. 1191779 for “Fish, and, More Particularly, Smoked and Marinated Fish; Preserved Tinned Fish; Fish Roe and, More Particularly, Salmon Roe, Lump-Fish Roe, Codfish Roe, Mullet Roe, Caviar; Goose and Duck Foie Gras, and Pastes and Creams Made from Foie Gras; Truffles” in International Class 29
- Registration No. 2340463 for “coffee, tea, chocolates, blinis, cakes, candy, caramels, mustard, vinegar, horseradish” in International Class 30
- Registration No. 1337271 for “Retail Store Services in the Field of Fancy Foods- Namely, Caviar, Smoked Salmon, Sea-Food, Liver Pate, Alcoholic Beverages, Wines, Spirits, Cheese, Gastronomical Specialties, Truffles, and Pre-Cooked

Meals Made of Meat, Fish or Poultry; Restaurant Services” in International Class 42

After the Examining Attorney rejected the Section 2(f) claim on the ground that the goods and services listed in the registrations are not sufficiently similar or related to those in the application, Applicant countered with evidence meant to show the relatedness of the goods and services. However, the Examining Attorney deemed the evidence unpersuasive.

As set forth in *Olin*, the relevant inquiry under Rule 2.41(a)(1) is whether the goods in the prior registrations are “sufficiently similar or related” to the goods in the new application. 124 USPQ2d at 1334; *see also In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (*du Pont* factor commonly referred to as relatedness of the goods articulated as “[t]he similarity or dissimilarity and nature of the goods”). Relatedness of goods can be established when the evidence shows that goods of this type emanate from the same source. *See Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012).

We focus our analysis on Registration No. 2340463 for the mark **PETROSSIAN**, which covers goods such as coffee, tea, chocolates, candy, vinegar and mustard. To show its applied-for soaps and cosmetics sold in delicatessens are “sufficiently similar or related” to the goods in the prior registration, Applicant provided:

- 13 live, use-based third-party registrations containing the applied-for cosmetics/soaps as well as at least some of the goods identified in Applicant’s Registration No. 2340463.<sup>4</sup>

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<sup>4</sup> TSDR April 7, 2017 Response to Office Action at 2 (Reg. No. 1148595 identifies, *inter alia*, soap and coffee, chocolate, cake, vinegar, mustard); *id.* at 5-6 (Reg. No. 2151066 identifies, *inter alia*, cosmetics and candy, mustard, vinegar); *id.* at 7-8 (Reg. No. 2183205 identifies,

- Webpages from Crabtree & Evelyn showing that mark used on teas, soaps and creams.<sup>5</sup>

We bear in mind the limitation in Applicant's identification, of the goods "being sold in delicatessen shops," and take judicial notice of the following definition of "delicatessen": "a store selling foods already prepared or requiring little preparation for serving, as cooked meats, cheese, salads, and the like."<sup>6</sup> *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (dictionary definitions); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006) (online dictionaries that exist in printed format or regular fixed editions). Applicant's evidence of 13 probative use-based third-party registrations that include under the same mark the applied-for goods and the goods in Applicant's prior registration suggest that such goods are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783,

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*inter alia*, cosmetic items and candy, cakes, mustard, and vinegar); *id.* at 16 (Reg. No. 4382187 identifies, *inter alia*, soap, cosmetics, vinegars, and mustards); *id.* at 17-19 (Reg. No. 4400455 identifies, *inter alia*, soap and tea, coffee, candies, and cakes); *id.* at 20-21 (Reg. No. 4727830 identifies, *inter alia*, skin soap and coffee, tea, vinegar, mustard, and chocolate); *id.* at 28-29 (Reg. No. 5069202 identifies soaps, coffee, and horseradish); *id.* at 30-31 (Reg. No. 5085466 identifies soap and chocolate bars); *id.* at 32-33 (Reg. No. 5108487 identifies cosmetics, candy, and tea); *id.* at 34 (Reg. No. 511092 identifies cosmetics and tea); *id.* at 35-36 (Reg. No. 5150222 identifies soap, cosmetics, coffee, tea, and vinegar); *id.* at 37 (Reg. No. 5152614 identifies soaps, cosmetic items, chocolate, and tea); *id.* at 38-39 (Reg. No. 5164455 identifies cosmetics and candy). The Examining Attorney correctly points out that Reg. No. 3923300 has been cancelled. We also give little weight to certain other registrations in which the identifications contained such a broad range of diverse goods and services as to diminish the probative value for this purpose, but we do not agree that all the registrations so characterized by the Examining Attorney are unreasonably broad.

<sup>5</sup> 4 TTABVue 54-55 (Applicant's Request for Reconsideration) (crabtree-evelyn.com).

<sup>6</sup> Dictionary.com entry for "delicatessen," accessed June 13, 2018, based on the Random House Unabridged Dictionary.

1785-86 (TTAB 1993). The Crabtree & Evelyn website provides actual marketplace evidence that teas are offered under the same mark as soaps, essential oils and cosmetics. Also, Applicant has specified that its applied-for goods are sold in delicatessens, and the goods in its prior registration consist of food items that might be sold in delicatessens, increasing the likelihood that acquired distinctiveness would transfer to the goods in the application as they will move in the same trade channels to at least some of the same consumers. Based on the evidence, we find the goods sufficiently related for purposes of the transfer of acquired distinctiveness.

The Examining Attorney argues, citing the Trademark Manual of Examining Procedure (“TMEP”) and *Olin*, 124 USPQ2d 1327, that the relatedness of the goods is not “self-evident” and the registration therefore cannot be accepted under Rule 2.41(a).<sup>7</sup> However, the guidance in the TMEP and *Olin* does not indicate that relatedness *must* be evident on the face of the identifications, but only that *if* relatedness is “self-evident,” no other evidence is needed. *See* TMEP § 1212.04(c) (Oct. 2017) (“If the similarity or relatedness is self-evident, the examining attorney may generally accept the §2(f) claim without additional evidence”). The TMEP makes clear that in the absence of “self-evident” relatedness, an applicant must provide “evidence and an explanation demonstrating the purported similarity or relatedness between the goods or services.” *Id.* Unlike in *Olin*, where the identifications showed very different goods and the applicant explicitly conceded this difference without offering argument or evidence of relatedness, 124 USPQ2d at 1335, in this case, Applicant

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<sup>7</sup> 9 TTABVue 9-10 (Examining Attorney’s Brief).

provides the requisite evidence and explanation why the applied-for goods should be considered related to the goods in its prior registration. According to Applicant, the third-party registrations and website evidence show that “customers are accustomed to seeing the same entity’s mark used for such goods, and would therefore assume that a single source is involved when the same mark is used for such goods in other cases.”<sup>8</sup>

Based on our finding as to Registration No. 2340463, we need not address Applicant’s other two prior registrations. Applicant met its burden of showing acquired distinctiveness as to its identified goods.

**Decision:** The refusal to register Applicant’s mark under Section 2(e)(4) of the Act is reversed, because the mark has acquired distinctiveness under Section 2(f) of the Act based on Applicant’s ownership of Registration No. 2340463.

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<sup>8</sup> 7 TTABVUE 10 (Applicant’s Brief).